

REMARKS

Reconsideration of this application, as presently amended, is respectfully requested. Claims 95-127 and 130 are pending in this application. Claims 95-127 and 130 stand rejected.

Summary of Interview

The Applicants would like to thank Mr. Vincent, the Supervisory Patent Examiner, for the courtesies extended to Applicants' representative during the telephonic interview conducted on February 5, 2009. Prior to the interview, a proposed response to the final Office Action was forwarded to Mr. Vincent for discussion during the interview. In particular, the proposed response included arguments traversing the rejections under 35 U.S.C. §112, first paragraph, and 35 U.S.C. §101 set forth in the final Office Action.

With respect to the 35 U.S.C. §112, first paragraph, rejections, Mr. Vincent indicated that, based on the arguments presented in the proposed response, it appeared that the 35 U.S.C. §112, first paragraph, rejections should be overcome. Further, Applicants' representative pointed out that if the §112, first paragraph, rejections are overcome, then the 35 U.S.C. §101 rejection will also be overcome because the §101 rejections are based on the §112, first paragraph rejection.

Finally, Mr. Vincent noted that the recitation of "physical structure" was not consistent throughout the claims. Accordingly, the claims have been amended to change instances of "structure" to --physical structure-- throughout the claims. These amendments do not raise new

issues requiring further consideration and/or search and simply render the claim language consistent throughout.

The detailed arguments addressing the rejections are set forth below.

Claim Rejections – 35 U.S.C. §112, first paragraph

Claims 95-127 are rejected under 35 U.S.C. §112, first paragraph, for allegedly failing to comply with the written description requirement. Claims 95-127 are rejected under 35 U.S.C. §112, first paragraph, for allegedly failing to comply with the enablement requirement. Claim 130 is rejected under 35 U.S.C. §112, first paragraph, for allegedly failing to comply with the written description requirement. Claim 130 is rejected under 35 U.S.C. §112, first paragraph, for allegedly failing to comply with the enablement requirement. For the reasons set forth in detail below, these rejections are respectfully traversed

Claims 95-127

Each of the rejections of claims 95-127 under §112(1) is based on the language “a user actuable controller to select outputs on the display screen in a design process,” which was added to claim 95 by the previous Amendment.

The Office Action asserts that the specification lacks *written description* support for a “user actuable controller to select” and asserts that the specification would not *enable* one of ordinary skill in the art to make and/or use the claimed invention. The Examiner asserts that

there is no hardware support (e.g., a mouse, keyboard, etc.) in the specification for a “user actuable controller.”

Written description requirement

For the reasons set forth below, the 35 U.S.C. §112, first paragraph, rejection of claims 95-127 based on the written description requirement is respectfully traversed.

The Office Action contends that Applicant’s disclosure does not sufficiently describe the “user actuable controller to select outputs on the display screen” in a manner that reasonably conveys to one skilled in the art that the inventors had possession of the claimed invention.

The Manual of Patent Examining Procedure (MPEP), in its guidelines regarding the written description requirement, indicates that when a disclosure describes a claimed invention in a manner that permits one skilled in the art to reasonably conclude that the inventor possessed the claimed invention the written description requirement is satisfied (see MPEP §2163).

To satisfy the written description requirement all that is required is that the applicant must convey “with *reasonable clarity* to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention now claimed.” [Emphasis added] (MPEP §2163.02). An applicant shows possession by of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures diagrams and formulas that set forth the claimed invention (MPEP §§2163(I), 2163.02).

However, the MPEP makes clear that Applicant *need not describe every claim feature exactly* because there is no *in haec verba* requirement (MPEP §2163B). Further, the MPEP

makes clear that an adequate description showing this possession may be made through express, implicit, or even inherent disclosure (see MPEP §2163B).

Finally, it is important to be mindful of the generally inverse correlation between the level of skill and knowledge in the art and the specificity of disclosure necessary to satisfy the written description requirement. That is, information which is well known in the art need not be described in detail in the specification (MPEP §2163(II)(A)(2)) (inventions in “predictable” or “mature” arts require a lesser showing of possession than inventions in more “unpredictable” arts).

As the Office Action notes, independent claim 95 now recites “a user actuable controller to select outputs on the display screen in a design process.” Applicants respectfully submit that one of ordinary skill in the art would reasonably conclude that Applicants’ disclosure adequately described the claimed invention in a manner that satisfies the written description requirement at the time of filing for at least the following reasons:

(1) the feature of the “user actuable controller to select outputs on the display screen” is at least impliedly taught by the present application as it was originally filed; and

(2) the art to which the claimed invention belongs is mature and the predictable nature of the art mandates a generally lower showing of possession.

More specifically, first, the originally filed specification discloses that the present invention relates to computer aided design (see page 1, line 5). Moreover, the specification describes that the genetic design apparatus shown in Fig. 1 of the drawings includes a computer 1, which may be a general purpose computer (see specification page 5, line 19 – page 6, line 4).

It is submitted that those of ordinary skill in the art would understand that such a disclosure at least implies the presence of some controller that can be actuated by the user to select an output on the display 8. In particular, it is well-known in the art that a computer or a computer aided design system impliedly (or inherently) has some sort of user actuable device, such as a keyboard or mouse, to interact with the computer.

Furthermore, page 9, lines 13-14 of the specification describes with respect to Fig. 7 of the drawings, which illustrates an output on display 8 of the present invention, "*Clicking* on a displayed profile allows the user to edit the concepts and attributes of the concepts of the selected profile." [Emphasis added]. Also, Fig. 7 illustrates a display generated on the display 8 of the present invention including a toolbar 25 provided with icons for various editing functions.

It is submitted that those of ordinary skill in the art would understand that "clicking" clearly implies a mouse function, and that those of ordinary skill in the art would clearly recognize that a tool bar with icons clearly implies some sort of user actuable device (e.g., a mouse) to select the various icons.

Still further, the specification describes that a user may alter attributes through the profile editor 4, which includes the use of icons to make changes and dialog menus in which specific values may be entered (see, e.g., specification page 7, lines 2-5). It is submitted that this disclosure taken with the above-noted disclosure further emphasizes that the disclosure implicitly includes a user actuable controller to select outputs on the display screen, e.g., an icon, in a design process.

In view of the foregoing, Applicants respectfully submit that one of ordinary skill in the art would reasonably conclude that Applicants possessed the claimed “a user actuable controller to select outputs on the display screen in a design process” on the basis of the aforementioned at least implicit descriptions. Applicants further submit that this conclusion is buttressed by the maturity and predictability of the art and because an adequate disclosure need not be express or even implied. Thus, it is respectfully submitted that the present application adequately meets the written description requirement of §112, first paragraph, for the presently claimed invention.

Enablement Requirement

The Office Action takes the position that the specification does not enable one of ordinary skill in the art to make and use the invention because the specification is not enabling for “a user actuable controller to select outputs on the display screen in a design process”

The test of enablement is whether the disclosure, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the art to make and use the claimed invention without undue experimentation.

The arguments stated above with respect to the “written description” requirement are incorporated by reference. In summary, it is submitted that given that the original specification at least implies a user actuable controller (see discussion above), and given the predictability of the art and low level of skill required for one of ordinary skill in the art to understand, based on the disclosure, that a device, such as a mouse or keyboard, etc. is commonly used to interact with a

computer, it is submitted that the specification clearly enables one of ordinary skill in the art to make and use the claimed invention without undue experimentation..

Claim 130

The Office Action rejects claim 130 under §112, first paragraph written description requirement and enablement based on the language “selection device”. The rationale for the rejection is similar to that discussed above for claims 95-127.

It is submitted that the arguments set forth above regarding the “user actuable controller to select outputs on the display screen in a design process” also apply to the “selection device.” In particular, it is submitted that the “user actuable controller to select” encompasses a selection device, and therefore the arguments with respect to claims 95-127 also apply to claim 130.

Claim Rejections- 35 U.S.C. §101

Claims 95-127 and 130 were rejected under 35 U.S.C. §101 for allegedly lacking patentable utility. More specifically, the Office Action asserts that because there is no support under §112, first paragraph, for a “user actuable controller” (claims 95-127) or a “selection device” (claim 130), the claimed invention cannot be used as recited in claims 95-127 and 130 and therefore lacks patentable utility.

First, it is submitted that in view of the arguments above to obviate the §112, first paragraph rejection, this rejection should be rendered moot.

Second, it is submitted that the basis for the rejection under §101 is improper. More specifically, the MPEP makes clear that “the requirement of 35 U.S.C. 112, first paragraph as to how to use the invention is different from the utility requirement of 35 U.S.C. 101. The requirement of 35 U.S.C. 101 is that some specific, substantial, and credible use be set forth for the invention. On the other hand, 35 U.S.C. 112, first paragraph requires an indication of how the use (required by 35 U.S.C. 101) can be carried out, i.e., how the invention can be used.” See MPEP 2164.07.

The present invention clearly has utility as a computer aided design method and system applicable to the design of automobiles and other structures. See page 1, lines 5-7 and page 9, lines 18-21 of the application specification. As noted above, the requirement of 35 U.S.C. 101 is that some specific, substantial, and credible use be set forth for the invention. This use is clearly set forth as noted above.

The MPEP goes on to state that “In some instances, the use will be provided, but the skilled artisan will not know how to effect that use. In such a case, ***no rejection will be made under 35 U.S.C. 101***, but a rejection will be made under 35 U.S.C. 112, first paragraph. As pointed out in *Mowry v. Whitney*, 81 U.S. (14 Wall.) 620 (1871), an invention may in fact have great utility, i.e., may be “a highly useful invention,” but the specification may still fail to “enable any person skilled in the art or science” to use the invention. 81 U.S. (14 Wall.) at 644.” [Emphasis added]. See MPEP 2164.07.

As discussed above, it is submitted that the rejections under §112, first paragraph, are obviated by the above remarks. However, even, assuming *arguendo*, that the §112, first

paragraph, rejection were proper, the MPEP makes it clear that it is improper to base a lack of utility rejection under §101 on an alleged lack of enablement under §112. In other words, contrary to the position taken in the Office Action, an alleged lack of enablement does not invoke a lack of utility rejection. Vice versa, a lack of utility under §101 does invoke a rejection under §112, first paragraph, based on failure to satisfy the “how to use” prong of 35 U.S.C. §112, first paragraph. That is, courts have determined that one cannot teach how to use an invention that is not useful (i.e., lacks utility).

For all of the reasons set forth above, reconsideration and withdrawal of the rejection under §101 are respectfully requested.

Moreover, it is noted that in Item 9 of the Office Action, the Examiner asserts that because the application allegedly fails to satisfy the utility requirement of §101, then the application fails under §112, first paragraph, to enable one of ordinary skill in the art to make and use the invention. However, as noted above, the present application satisfies the utility requirement. Therefore, this rejection is improper and should be withdrawn. Accordingly, reconsideration and withdrawal of the rejection set forth in Item 9 of the Office Action are respectfully requested.

Finally, although no rejection under §101 for alleged non-statutory subject matter is at issue, it is submitted that the claims satisfy the current test for patent eligible subject matter under §101 articulated in *In re Bilski*.

Moreover, it is noted that in the *Bilski* case, the Federal Circuit approved an earlier court’s holding patentable (under §101) a claim drawn to the transformation of data representing

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physical objects ("Thus, the transformation of that raw data into a particular visual depiction of a physical object on a display was sufficient to render that more narrowly-claimed process patent-eligible.")

CONCLUSION

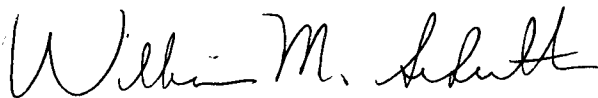
In view of the foregoing, it is submitted that all pending claims are in condition for allowance. A prompt and favorable reconsideration of the rejection and an indication of allowability of all pending claims are earnestly solicited.

If the Examiner believes that there are issues remaining to be resolved in this application, the Examiner is invited to contact the undersigned attorney at the telephone number indicated below to arrange for an interview to expedite and complete prosecution of this case.

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

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